

## REMARKS

This Response is submitted in reply to the Final Office Action dated May 14, 2003. Claims 1, 13, 19, 21 and 25 have been amended. New Claims 26 to 41 have been added. No new matter has been added by any of the amendments made herein. A Request for Continued Examination and a Petition for a One Month Extension of Time to respond to the Final Office Action are submitted herewith. A Supplemental Information Disclosure statement is submitted herewith. A check in the amount of \$1232 is submitted herein to cover the cost of the RCE, the one month extension of time, the Supplemental Information Disclosure Statement and the newly added claims. Please charge Deposit Account 02-1818 for any insufficiency or to credit any overpayment.

Claims 1 to 25 were rejected under 35 USC § 103(a) as being unpatentable over United Kingdom Application No. GB-2,144,644 A to *Barrie* ("*Barrie*") in view of the *Take Your Pick* Article ("*Take Your Pick*").

Amended Claim 1 is directed to a gaming device including a processor and a plurality of selections where a plurality of awards are associated with the selections. The gaming device also includes at least one supplementing award associated with at least one of the selections, wherein the supplementing award is adapted to be provided to a player by the processor when the player picks the selection associated with the supplementing award. The supplementing award includes an award which is automatically provided to the player and at least one additional award generation which automatically provides an independent additional award to the player. Claim 1, as amended, is patentably distinguished over the combination of *Barrie* and *Take Your*

*Pick* because this combination does not disclose, teach or suggest the combination of all of the elements of Claim 1.

The Patent Office admits that *Barrie* does not disclose all of the elements of the claimed invention. Specifically, the Patent Office states that “*Barrie* does not expressly disclose at least one supplementing award associated with at least one of the selections and the supplementing award including an award provided to the player as recited in Claims 1, 13, 19, 21 and 25.” (Final Office Action, page 3)(emphasis added).

The Patent Office therefore relies on *Take Your Pick* to remedy the deficiencies of *Barrie*. In particular, the Patent Office states that *Take Your Pick* teaches a supplementing award associated with at least one of the selections where the supplementing award includes an award provided to the player. The Patent Office interpreted the award, which is provided to the player, to be “the two circles having one circle with a coin value being randomly generated as the award and the second circle being the multiplier also being randomly generated as the supplemental award . . . .” (Final Office Action, page 3). The Patent Office further states the following:

“By having a supplemental award one of ordinary skill in the art would allow game players a guaranteed win. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to modify *Barrie* to include at least one supplementing award associated with at least one of the selections and the supplementing award including an award provided to the player . . . .” (Final Office Action, page 3).

Applicants respectfully disagree with the Patent Office because the combination of *Barrie* and *Take Your Pick* does not disclose, teach or suggest the claimed invention. As described above, the claimed invention is directed to a gaming device including a supplementing award where the supplementing award provides an award, which is

automatically provided to a player, and at least one additional award generation which automatically provides an independent additional award to the player. Therefore, when a player picks a selection including a supplementing award, the gaming device provides the player with an award and an additional award generation which provides another separate or independent award to the player (i.e., two independent awards).

A claimed invention is patentable unless the differences between the invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103; *In re Gartside*, 203 F.3d 1305, 1319, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The key issue is what the references teach and whether they teach the necessity of combination or the requirement of separation. *McGinley v. Franklin Sports*, 262 F.3d 1339, 1355, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001).

*Barrie* discloses a video gaming machine that provides a player with a number of selections or choices in a single bonus game. The player picks one of the selections or choices to reveal a reward class, a lose class or a win class. If the player picks a selection including a lose class, the game ends. If the player picks a selection including a reward class, the gaming machine provides a reward to the player and the game ends (see specification page 2, lines 67 to 68). If the player picks a selection including a win class, the gaming device enables the player to continue playing the game and picks a selection from a new set of selections. Each time the player picks a selection including

a win class, the gaming device enables the player to terminate the game and receive a designated reward or continue to play the game by rejecting the reward (and thereby not receive a reward at that time) to possibly obtain a larger reward in the game (Specification page 2, lines 59 to 65). As a result, with each set of selections, the player may obtain a single reward or reject the reward and attempt to obtain a larger reward.

*Take Your Pick* discloses a gaming machine having a base game (i.e., a reel game) and a bonus game. In the bonus game, two lighted circles are displayed to a player on a top box. One of the circles includes bonus coin amounts and the other circle includes bonus multiplier amounts. When the bonus game is initiated from the base game, one coin amount and one multiplier is displayed to the player. The player may either accept the award (i.e., which is the indicated coin amount multiplied by the indicated multiplier) or try again. If the player chooses to try again, the player may change both the indicated coin amount and the indicated multiplier only once, or take two turns changing either the indicated coin amount or the indicated multiplier. When an "offer" is accepted or two turns or changes have been made, the indicated coin amount is multiplied by the indicated multiplier to provide a total award to the player. As described above, the total award is not automatically provided to the player until two changes are made. In addition contrary to the claimed invention, the gaming device provides only one award to the player where the award includes two related components - the coin amount and the multiplier.

Even if *Barrie* and *Take Your Pick* are combined, the combination does not disclose, teach or suggest the combination of elements of Claim 1. *Barrie* discloses a gaming machine which enables a player to pick a selection from a plurality of selections.

If the player picks a selection including a win class, the player receives a reward. The player may then choose to keep the reward or reject the reward to attempt to obtain a larger reward in the game. Thus, the player only receives one reward in *Barrie*. *Take Your Pick* discloses a bonus game which displays two related components (i.e., a coin value and a multiplier), which are combined to form one award which is provided to the player. *Take Your Pick* does not teach or suggest that these components may be provided separately or independently to the player. Therefore, the combination of *Barrie* and *Take Your Pick* does not disclose, teach or suggest a supplementing award which automatically provides an award to a player and at least one additional award generation which automatically provides an independent additional award to the player.

For the reasons provided above, the combination of *Barrie* and *Take Your Pick* does not disclose, teach or suggest the elements of Claim 1. Therefore, Claim 1 and Claims 2 to 12 which depend from Claim 1, are each patentably distinguished over the combination of *Barrie* and *Take Your Pick* and in condition for allowance.

Amended Claim 13 is directed to the gaming device which includes a processor, a plurality of selections and a plurality of awards associated with the selections. Additionally, the gaming device includes at least one supplementing award associated with the selections and adapted to be provided to a player by the processor. The supplementing award includes an award which is automatically provided to the player and a random award generation which automatically provides an independent additional award to the player.

As described above, the combination of *Barrie* and *Take Your Pick* does not disclose, teach or suggest a gaming device including a supplementing award which

automatically provides an award and a random award generation which provides an independent additional award to a player when the player picks a selection associated with the supplementing award. For at least these reasons, the combination of *Barrie* and *Take Your Pick* does not disclose, teach or suggest the claimed invention. Therefore, amended Claim 13 and Claims 14 to 18, which depend from independent Claim 13, are each patentably distinguished over *Barrie*.

Amended Claim 19 is directed to a gaming device including a processor and a plurality of awards. Additionally, the gaming device includes a plurality of supplementing awards adapted to be provided to a player by the processor. Each of the supplementing awards includes one of the awards which is automatically provided to the player and an award generation that chooses one of the plurality of awards which is an independent additional award automatically provided to the player for said supplementing award. As described above, the combination of *Barrie* and *Take Your Pick* does not disclose, teach or suggest a plurality of supplementing awards which automatically provide an award from a plurality of awards to the player and an award generation that automatically provides an independent additional one of the awards to the player. For at least these reasons, amended Claim 19 and Claim 20, which depends from Claim 19, are each patentably distinguished over the combination of *Barrie* and *Take Your Pick*.

Amended Claim 21 is directed to a gaming device that includes a display device and a processor adapted to communicate with the display device. The display device and processor are adapted to enable a player to pick at least one selection from a plurality of selections, generate a supplementing award associated with one of the

selections, automatically provide an award to the player associated with the supplementing award and provide an award generation associated with the supplementing award if the player picks the selection associated with the supplementing award wherein the award generation automatically provides an independent additional award to the player. For the same reasons stated above, the combination of *Barrie* and *Take Your Pick* does not disclose, teach or suggest a gaming device that generates a supplementing award associated with one of the selections, wherein the supplementing award includes an award which is automatically provided to a player and an award generation which automatically provides an independent additional award to the player. For at least these reasons, amended Claim 21 and Claims 22 to 24, which depend from Claim 21, are each patentably distinguished over the combination of *Barrie* and *Take Your Pick*..

Amended Claim 25 is directed to a gaming device including a display device and a processor adapted to communicate with the display device. The display device and processor are adapted to enable a player to pick at least one selection from a plurality of selections, generate a supplementing award associated with one of the selections, automatically provide an award to the player associated with the supplementing award if the player picks the associated selection with the supplementing award and provide an award generation associated with the supplementing award if the player picks the associated selection with the supplementing award wherein the award generation automatically yields an independent additional award provided to the player and another supplementing award which automatically provides a further independent additional award to the player. For the reasons provided above, the combination of *Barrie* and

*Take Your Pick* does not disclose, teach or suggest a gaming device including a plurality of selections including a supplementing award wherein the supplementing award automatically provides an award to the player and also an award generation which provides another supplementing award to the player which automatically provides a further independent award to the player. Therefore, amended Claim 25 is patentably distinguished over *Barrie*.

Newly added Claim 26 is directed to a gaming device including a processor, a plurality of selections and a plurality of awards associated with the selections. The gaming device also includes at least one supplementing award associated with the selections, wherein the supplementing award includes an award which is automatically provided to the player and at least one additional award generation which automatically provides an independent additional award to a player. Furthermore, the gaming device includes a probability of selecting an award associated with each of the awards, and a processor which is operable to enable a player to pick one of the selections, randomly associate one of the awards with the picked selection based on the probabilities, automatically provide an award and at least one additional award generation that provides an independent additional award to the player when the supplementing award is associated with the picked selection and automatically provide one of the awards to the player when the supplementing award is not associated with the picked selection.

The combination of *Barrie* and *Take Your Pick* does not disclose, teach or suggest associating a supplementing award with the selections, where the supplementing award includes an award which is automatically provided to the player and at least one additional award generation which automatically provides an




independent additional award to a player. Moreover, the combination of *Barrie* and *Take Your Pick* does not disclose, teach or suggest associating a probability of selecting an award with each of the awards where a player picks one of the selections and the processor randomly associates one of the awards with the picked selection based on the probabilities associated with the awards. Accordingly, the combination of *Barrie* and *Take Your Pick* does not disclose, teach or suggest the elements of newly added Claim 26. Therefore, Claim 26 and Claims 27 to 41, which depend from Claim 26, are each patentably distinguished over the combination of *Barrie* and *Take Your Pick* and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the Applicants' attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Respectfully submitted,

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By 

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